REMARKS

In the Office Action, the Examiner has rejected claims 3-6. As no amendments are made in this Response, claims 3-6 are pending.

Rejection of Claims 3-5 under 35 USC § 103

The Examiner has rejected claims 3-5 under 35 U.S.C. §103(a) as being unpatentable over Nagasawa (U.S. Patent No. 6,782,281) further in view of Smith et al. (U.S. Patent No. 6,333,973).

In order "to establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught in the prior art." MPEP 2143.03.

Claim 3

The cited references of Nagasawa and Smith et al. do not teach or suggest all of the limitations of claim 3. In particular, the references do not teach or suggest a radio communication means that is operable in the first operating mode and de-energized in the second operating mode.

Nagasawa discloses a device that receives telephone calls and includes a pocket game machine. When the operator plays the game, the game is continuous as long as no call is received. Col. 6, ll. 11-12. At the time of a call, the game is suspended. Col 6, ll. 13-18. While the game is suspended, the user can press the call start button to begin a conversation. Col. 6, ll. 18-20. Alternatively, the user may press the start button and, instead of taking the call, release the call and resume the game function. Col. 6, ll. 28-36.

On page 3 of the Office Action, the Examiner states that because the Nagasawa teaches that when there is an incoming call, the caller information is displayed, the call start button is not pressed, the start button for a pocket game is pressed, and a message stored in memory is sent to release the call without forcibly suspending the pocket game, (citing Nagasawa, col. 6, ll. 28-47) it is obvious that the transmitter and receiver of the portable telephone is in a de-energized state. The passage in Nagasawa cited by the Examiner (Nagasawa, col. 6, ll. 28-47) refers to *releasing the call*, but is completely silent with regard to the communication unit being in a *de-energized state*. In fact, the term "de-energized" is not used anywhere in Nagasawa. Therefore, Nagasawa does not teach a communication means that is de-energized in a second state.

Moreover, this limitation is not taught or suggested by Smith. Smith is directed to a telephone set that has an integrated message center residing in a mobile telephone and which operates with a network provider to deliver messages such as fax, e-mail and voice mail. In particular, the message center is a unified mailbox through which the user is presented with all types of messages. *See* Col. 8, ll. 27-30. The user may use the message center to filter phone calls. *See* Col. 11, ll. 64-67.

Smith does not teach or suggest a mobile phone that has more than one operating mode. Thus, because there is no second operating mode, Smith cannot and does not teach a communication means that is de-energized in a second operating mode.

Thus, Nagasawa and Smith do not teach or suggest a radio communication means that is operable in a first operating mode and de-energized in a second operating mode because these references, either in combination or separately, do not teach, suggest or even mention a communication means that is de-energizing in a second state. Thus, Nagasawa and Smith do not

teach or suggest all of the limitations in claim 3. Therefore, it is respectfully requested that the rejection of claim 3 be withdrawn.

Claims 4 and 5

The Examiner has rejected claims 4-5 under 35 U.S.C. §103(a) as being unpatentable over Nagasawa further in view of Smith.

Nagasawa and Smith, either in combination or separately, do not teach each and every element present in independent claim 4 and dependent claim 5. Specifically, these references do not teach the following limitations: (a) "a second stop mode for holding the communication function unit in a de-energized state," so that (b) "the additional function unit may operate without interruption from the communication function unit." In addition, Nagasawa teaches away from an additional function unit that operates without interruption.

For the reasons given in response to the rejection of claim 3, neither Nagasawa nor Smith discloses a (a) mode in which the communication unit is in a de-energized state. Further, neither reference teaches holding the communication function in a de-energized state so that (b) "the additional function unit may operate without interruption." Because, as discussed above, neither Smith nor Nagasawa teach a second stop mode for holding a communication unit in a de-energized state, they cannot teach an additional function unit that can operate without interruption due to a communication unit held in a de-energized state.

Further, Nagasawa specifically teaches that an additional function unit (a pocket game) is suspended when there is an incoming phone call. See col. 6, ll. 21-38. Thus, Nagasawa specifically teaches away from allowing the additional function unit to operate without

interruption. With regard to Smith, this reference does not teach an additional function unit. Therefore, it does not have an additional function unit to operate without interruption.

Because Nagasawa and Smith do not teach or suggest all of the limitations recited in claims 4 and 5, it is respectfully requested that the rejection of claims 4 and 5 be withdrawn.

Rejection of Claim 6 under 35 USC § 103

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nagasawa (U.S. Patent No. 6,782,281) and Smith et al. (U.S. Patent No. 6,333,973) as applied to claim 4 and in further view of Shimanuki et al. (U.S. Patent No. 5,890,071).

Because claim 6 depends from claim 4, the cited references do not include the limitations of claim 6. As discussed above in connection with the rejection of claim 4, Nagasawa and Smith do not teach a second stop mode for holding the communication function unit in a de-energized state so that the additional function unit may operate without interruption from the communication function unit. This limitation is not taught or suggested by Shimanuki either. In fact, Shimanuki does not teach a second stop mode and teaches away from operating the additional function unit without interruption from the communication functional unit.

Shimanuki discloses a radio telephone set that includes a telephone section (used to receive and produce speech signals) and a tuner section (used to receive radio broadcasts). Col. 3, ll. 61-67. Further, Shimanuki discloses two power supply switches for connecting and disconnecting a power supply from the telephone section and the tuner section. When the radio telephone is in a "telephone mode" the first of the two power supply switches opens and closes to supply power in synchronization with the operating cycle of the phone receiver. When the radio telephone is in a "radio mode" the second of the two power supply switches closes to

power the radio section, and the first power supply switch is maintained in a closed position. Col. 4, ll. 36-52.

Shimanuki teaches only one mode where the communication function unit operates by "cycling" the first power supply switch. This mode occurs when the additional function unit (radio mode) does not operate. When the additional function unit operates, Shimanuki teaches that the communication function is on continuously, so that interference from the "cycling" of the first power supply switch is avoided. Thus, Shimanuki specifically teaches away from operating the additional function unit without interruption from the communication function unit because the communication function unit power switch (the first power supply switch) remains "energized." Shimanuki further teaches that a listener is alerted through various means when a call is received in the "radio mode." Thus, Shimanuki teaches interruption of the additional function unit.

The Examiner states that the wait state of Nagasawa can be combined with the on-off cycling of the communication function unit in Shimanuki to save power, and thus makes the apparatus of claim 6 obvious. However, combining Shimanuki with Nagasawa teaches that the "cycling" of the communication function unit power switch during the wait state causes interference with the additional function unit. Thus, there would no motivation to combine these references. But even if these references were combined anyway, Shimanuki and Nagasawa together still teach that the additional function unit is interrupted by the communication function unit. Therefore, Shimanuki, combined with Smith and Nagasawa, does not teach or suggest all of the limitations of claim 6. Thus, it is respectfully requested that the rejection of claim 6 be withdrawn.

CONCLUSION

In view of the statements set forth in this Response, it is respectfully submitted that the pending application, including claims 3-6, is in condition for allowance. Therefore, it is respectfully requested that the foregoing response be entered and the pending application be allowed.

The Examiner is invited to contact the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,

Dated: 3/29/06

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Attorney Docket No. 204935-9001